REMARKS

The Office Action dated December 18, 2003 has been reviewed and carefully considered. The Examiner's allowance of claims 1, 3 and 5 is appreciated. Claims 1-6 remain pending, of which the independent claims are 1-4. Reconsideration in view of the following remarks is respectfully requested.

Claims 2 and 4 stand rejected under 35 U.S.C. 102(e) as anticipated by PCT publication WO 99/51033 to Bailleul et al. ("Bailleul").

Claim 2 recites:

> a) a decoding step for decoding said encoded data signal and providing a decoded data signal, b) a re-encoding step performed on a modified data signal and generating a coding error, c) a prediction step for providing a motion-compensated signal from said coding error and comprising at least a subtracting sub-step between an input data signal obtained at least from said decoded data signal and said motion-compensated signal for obtaining said modified data signal, characterized in that it comprises a sub-step for adding an additional data signal to said modified data signal, before said re-encoding step.

Although we agree with item 3 of the Office Action that the DCT and Q blocks in FIG. 5 perform the re-encoding step, it follows from claim step b) that the "modified data signal" corresponds to $R_{(n,2)}$.

The latter proposition is re-iterated in claim step c), which specifies "a subtracting sub-step between an input data signal obtained at least from said decoded data signal and said motion-compensated signal for obtaining said modified data signal . . ." In particular, and as acknowledged by item 3 of the Office Action, the "decoded data signal" corresponds to $R'_{(n-1)}$. Accordingly, the "motion-compensated signal" in the claim can be none other than the signal between COMP and S. Here, too, item 3 of the Office Action acknowledges that the "subtracting sub-step" occurs at S.

Item 3 further acknowledges that the "sub-step for adding" occurs at A (ref. no. 54). A (ref. no. 54) has two inputs. One is the "additional data signal" from ref. no. 53. The other is "said decoded data signal," which item 3 acknowledges to be represented by $R'_{(n-1)}$. This other input therefore cannot be regarded as "said modified data signal," especially since the "modified data signal" corresponds to $R_{(n,2)}$ as set forth at the beginning in the first two analysis paragraphs for this section. Accordingly, although Bailleul may be characterized as featuring "a sub-step for adding an additional data signal **to** said decoded data signal, before said re-encoding step," Bailleul fails to disclose or suggest "a sub-step for adding an additional data signal **to** said modified data signal, before said re-encoding step" which is explicitly required by the language of claim 2.

OK to withdraw

For at least this reason, Bailleul fails to anticipate or render obvious the invention as recited in claim 2. Reconsideration and withdrawal of the rejection is respectfully requested.

Claim 4 is an apparatus claim that corresponds to method claim 2, and is likewise deemed to be patentable over Bailleul.

Claims 2 and 4 stand rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,181,743 to Bailleul ('743 patent) and anticipated by U.S. Patent No. 6,493,389 to Bailleul ('389 patent).

Item 4 of the Office Action refers to FIG. 5 of both patents, which is identical for both patents and which is identical to FIG. 5 of Bailleul which was herein discussed in the above section. Accordingly, claims 2 and 4 are each deemed to be patentable over the '743 and '389 patents, alone or in combination.

Claim 6 stands rejected under 35 U.S.C. 103(a) as unpatentable over each of Bailleul, the '743 patent and '389 patent. This proposition is traversed by the applicant on procedural grounds as to the U.S. patents and on substantive grounds as to all three references.

On substantive grounds, claim 6 depends from claim 2, which has been shown to be patentable, and is likewise patentable at least due to its dependency.

Procedurally:

35 U.S.C. 103 provides:

> (c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of **section 102** of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The U.S. references issued as patents on January 30, 2001 and on December 10, 2002, whereas the present application has priority dates on or before April

18, 2000. The U.S. patents could therefore only qualify as prior art under 35 U.S.C. 102(e), if not for 35 U.S.C. 103(c).

Neither of the '743 and '389 patents qualifies as prior art pursuant to 35 U.S.C. 103(c), because as to each of the references, at the time the invention was made, the subject matter of the reference and claim 6 of the present application were both owned by or subject to an obligation of assignment to Philips Electronics. Accordingly, the non-statutory double patenting rejection cannot be maintained. Reconsideration and withdrawal of the rejection is respectfully requested.

OK

Claim 2 stands rejected under the judicially-created doctrine of non-statutory double patenting as unpatentable over the '743 patent.

The above statute, 35 U.S.C. 103(c), applies in the case of non-statutory double patenting. See MPEP 804.03. Accordingly, the non-statutory double patenting rejection cannot be maintained for at least this reason. Reconsideration and withdrawal of the rejection is respectfully requested.

no 103(c) does not to apply double patenting

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

Russell Gross
Registration No. 40,007

Date: 3/16/04

By: Steve Cha
Attorney for Applicant
Registration No. 44,069

Mail all correspondence to:
Russell Gross, Registration No. 40,007
US PHILIPS CORPORATION
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9608
Fax: (914) 332-0615

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Steve Cha, Reg. No. 44,069
(Name of Registered Rep.)

(Signature and Date)